

#### IN THE UNITED STAPES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Steven W. Trovinger

Application No.: 10/698,504

Filed: October 30, 2003

Confirmation No.: 9590

For: METHOD AND APPARATUS FOR

MAKING BOOKLETS

PETITION UNDER 37 C.F.R. § 1.78(a)(3) TO ACCEPT AN UNINTENTIONALLY DELAYED REFERENCE UNDER 35 U.S.C. § 120 AND/OR § 365

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.78(a)(3), Applicant hereby requests the U.S. Patent and Trademark Office to accept the unintentionally delayed reference to the claim under 35 U.S.C. § 120 and/or § 365 in this application.

In accordance with 37 C.F.R. § 1.78(a)(3)(i), the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2) is concurrently submitted in the accompanying Response to the Official Action dated April 30, 2004.

In accordance with 37 C.F.R. § 1.78(a)(3)(ii), a fee of \$1,330.00 is required under 37 C.F.R. § 1.17(t). The Director is hereby authorized to charge Deposit Account No. 08-2025 for the fee due.



On information and belief, the entire delay between the date the reference to the claim under 35 U.S.C. § 120 and/or § 365 was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date the reference required by 37 C.F.R. § 1.78(a)(2) is submitted in this application was unintentional. The following facts are presented in support of this Petition.

- 1. The present application is a divisional application of parent Application Serial No. 09/831,768. The parent Application Serial No. 09/831,768, was filed as a § 371 national stage application of International Application No. PCT/US99/23078, which is also a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998.
- 2. The specification in parent Application Serial No. 09/831,768 did NOT contain a reference to the prior filed applications, because no such reference was required. The International Application was filed on September 29, 1999, and was therefore exempted per 37 C.F.R. 1.78(a)(2)(ii)(C) from the requirements of 37 C.F.R. §1.78 when the International Application was nationalized.
- 3. The present divisional application made a claim for priority to parent Application Serial No. 09/831,768, in the transmittal and to the International Application No. PCT/US99/23078 and to Continuation-in-Part Application No., 09/162,844, in the originally filed Declaration (see Attachment A). The present divisional application was filed on October 30, 2003, with a photocopy of the original specification of Application Serial No. 09/831,768.
- 4. Because the original specification of parent Application No. 09/831,768 did not contain a cross-reference to the International Application or CIP Application, the photocopy of the parent used to file the present divisional application did not contain a cross-reference to the International Application.
- 5. The present application was amended at the time of filing to include a cross-reference to Application Serial No. 09/831,768 (see Preliminary Amendment Attachment B). However, a cross-reference to the International Application and CIP Application was unintentionally not included in the Preliminary Amendment.
- 6. Upon becoming aware of the failure to timely meet the requirements of 37 C.F.R. §1.78, we promptly prepared and submitted this Petition to make the cross-reference to the International Application and CIP Application on page 1 of the specification in the present divisional application.

Accordingly, because all requirements for a proper Petition Under 37 C.F.R. §1.78 have been satisfied, granting of this Petition to recognize Applicant's claim for priority to the International Application is requested.

Date: 1/1/16, 2004

Patrick C. Keane



Attorney Docket No.

#### STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Steven W. Trovinger

Group Art Unit: 3651

Application No.: 10/698,504

Examiner: Patrick Hewey Mackey

Filing Date:

October 30, 2003

Confirmation No.: 9590

Title: METHOD AND APPARATUS FOR MAKING BOOKLETS

#### REQUEST FOR WITHDRAWAL OF HOLDING OF **ABANDONMENT - NO ABANDONMENT IN FACT**

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In accordance with M.P.E.P. § 711.03, withdrawal of the holding of abandonment in the above-captioned application is respectfully requested, there being no abandonment in fact. Specifically, the Notice of Abandonment issued on February 11, 2005 states that the application is held abandoned for failure to respond to the Patent and Trademark Office communication dated April 16, 2004

However, a reply to that communication was timely filed on July 16, 2004 . A copy of that reply (i.e., the reply dated July 16, 2004) is enclosed, as is a copy of a postcard receipt date-stamped by the Patent and Trademark Office acknowledging receipt of said reply on said date. This date-stamped postcard receipt, which itemizes and properly identifies the papers filed, is prima facie evidence of receipt in the Patent and Trademark Office of all the items listed thereon on the date stamped thereon by the Patent and Trademark Office. See, M.P.E.P. § 503.

In light of the above, withdrawal of the holding of abandonment and prompt and favorable action on the merits are respectfully requested.

It is believed that no fee is required for consideration of this paper. Should the Office deem otherwise, the Director is hereby authorized to charge any appropriate fees under 37 C.F.R. § 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Patrick C. Keane

Date: March 3, 2005

Registration No. 32,858

I hereby certify that this document is being filed by personal delivery to the Customer Service Window Randolph Building, 401 Dulany Street Alexandria, VA 22314, of the United States Patent & Trademark Office on the date indicated above.

REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT - NO ABANDONMENT IN FACT



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	Patent Kesp	Patent Response Postcard	}	
nventor: Steven W. Trovinger		Appln. No.: 10/698,504	Filing October 30, 2003	
Jocket No.: 10991471-13 (-180)	Working Atty.:	JGK/geh	Date: July 16, 2004	
OK. Clerprinitials 039842-180				
The following was/were	lowing was/were received in the U.S. Patent and Trademark Office on the date stamped hereon:	and Trademark Office on	n the date stamped hereon:	
X Amendment or Response	Executed Declaration/Power of Attorney	ower of Attorney	Request for Corrected Filing Receipt	
Preliminary Amendment	Assignment/Assignment Recordation Form	t Recordation Form	w/copy of Official Filing Receipt  Substitute Specification (clean/marked copies)	
X Amendment/Reply Transmittal Letter	Cover Sheet (PLC-1555)	5) Comit of Drivith, Door mont	Check for \$ is enclosed	
Petition for Month Extension of Time	w/ certified copy(ies)	Submission of Ceruiled Copy of Priority Document w/ certified copy(ies)		
Submission of Formal Drawings w/	Information Disclosure Statement Transmittal	Statement Transmittal	CENTRAL DO	
sheet(s) of drawings (Fig(s). 1)	Information Disclosure Citation (PTO-1449)	Citation (PTO-1449)		
Request for Approval of Drawing Changes	X  Information Disclosure Statement w/	Statement w/ O troughment(s)	PTO-2038 is attached.	
W/ Sheet(s) of red link drawings	Request for Corrected	of Recordance of		
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Express	Express Mail Mailing Label No.			

Method And Apparatus For Making Booklets  The specification of which is attached hereto unless the following box is checked:  (X) was filed on Sap 29, 1999 as US Application Serial No. or PCT International Application (if applicable).  It hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Persign Application(s) and/or Claim of Foreign Priority  I hereby claim foreign priority benefits under Title 35, United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate is a period to the application on which priority is claimed:  COUNTRY  APPLICATION NUMBER  DATE FLED  PROTIVES99/23078  DATE FLED  PROTIVES99/23078  DATE FLED  PROTIVES DATE  NO:  PROTIVES STATUS (DATE STATUS (DATE)  NO:  APPLICATION SERIAL MUMBER  FILMS DATE  U. S. Priority Claim  APPLICATION SERIAL MUMBER  FILMS DATE  STATUS (parametric) belowed this application and transact all and are application and transact all As a parend inventor. I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all As a parend inventor. I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all As a parend inventor. I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and tra	•			10	PE		PATENI	APPLICATION
My residence/post office address and citizens/Michael Busham Provided below next to my name;  I believe I am the original, first and gole inventor (if Diving one name is listed below) or an original, first and gole inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is scuph to the invention entitled:  Mothed And Apparatus For Making Booklets  the specification of which is attached herato unless the following box is checked:  CX) was filled on Sep 29, 1999 as US Application Serial No. or PCT International Application, Number US99/22078 and was amended on (if epplicable).  I hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendments; referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Application(a) ander Claim of Foreign Priority the claims; as amended by any amendments; referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Application(a) ander Claim of Foreign Priority the claims; and the priority is claimed.  Foreign Application and any abordised below any foreign application for patent or inventorical certificate listed below and have also identified below any foreign application for the priority is claimed.  CILINTY AMULATION MARKS DATE FILED PRIORITY CLASSIFICATION PRIORI			OF ATTORNEY	FEB	0 3 2005	ATTORNE	Y DOCKET NO. 10	991471-1
My residence/post office address and citizens/Micage_gate_gate_gate_ballow next to my name;  I believe I am the original, first and gole inventor (if office on ame is listed below) or an original, first and gole inventor (if office on ame is listed below) or an original, first and point inventor (if office on ame is listed below) or the subject matter which is claimed and for which a patent is scught on the invention entitled:  Method And Sparatus For Making Booklets  The specification of which is attached herato unless the following box is checked:  (X) was filled on Sep 29, 1999 as US Application Serial No. or PCT International Application (if epplication), for the sparatus for many and was amended on (if epplication).  I heraby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendments; referred to above. I schowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Applicationals ander Claim of Fereign Priority the claims; information which is material to patentability as defined in 37 CFR 1.56.  Foreign Applicational sander Claim of Fereign Priority in claims.  I heraby claim foreign priority bearings under Title 35, United States Code Section 119 of any foreign applicational carrificate having a filling data bottom that of the application on which in priority is claims.  CILINTY  PCT PCT/US99/23078 09/29/99 Priority Claims (in the priority is claims.)  CILINTY  APPLICATION NAMES ON TITLE OF APPLICATION NAMES ON TITLE OF APPLICATION SERIAL NAMES ON TITLE APPLICATION SERIAL NAMES ON TITLE OF APPLICA	As a below named inve	ntor, I	hereby declare	gat:	\$			
believe   am the original, first and 30le inventor (if only one latine is active below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:  Method And Apparatus For Making Bookdats  The specification of which is attached hereto unless the following box is checked:  (X) was filed on Sep 29, 1999	My residence/post offic	e addre	ess and citizensi	No Ronge	BS Specified be	slow next	to my name;	
the specification of which is attached hereto unless the following box is checked:  (X) was filled on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/2307B and was amended on [if applicable].  (Interaby state that I have reviewed and understood the contents of the above-identified specification, reluding the claims, as amended by any emendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Application and and/or Claim of Foreign Priority heretis under Title 35, United States Code Section 119 of any foreign application(s) for petent or inventoris) certificate State below and have also identified below any foreign application for patent or inventoris) certificate State below and have also identified below any foreign application for patent or inventoris) certificate State below and have also identified below any foreign application for patent or inventoris) certificate State below and have also identified below any foreign application for patent or inventoris) certificate State below and have also identified below any foreign application for patent or inventoris) certificate State States St	l believe I am the origin Joint inventor (if plural	ial, first names	and sole invent are listed belov	or ur c	oniv one nati	18 13 115 180	DEIOWI UI all UI	iginal, first and nd for which a
NC) was filed on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/23078 and was emended on [if applicable]. [if applicable].  It hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Applicational and/or Claim of Foreign Priority I hereby claim foreign priority banefits under Titls 35, United States Code Section 119 of any foreign application(s) for patent or inventorial certificate having a filing date before that of the application on which priority is claimed:  COUNTRY APPLICATION MANDERS DATE TABLE TRUE TRUE TABLE UNDER SUBJECT TO PCT/US99/23078 09/29/99 PTES X Not.  PCT PCT/US99/23078 09/29/99 PTES X Not.  PTOVISIONAL APPLICATION SERVAL NUMBER PRUNCH CLAIMED UNDER SUBJECT TO THE PCT/US99/23078 09/29/99 PTES X Not.  PROVISIONAL APPLICATION SERVAL NUMBER PRUNCH CLAIMED UNDER SUBJECT TO THE PCT/US99/23078 09/29/99 PTES X Not.  O, S. Priority Claim I hereby claim the benefit under Title 35, United States Code Section 119(a) of any United States provisional application(s) fisted below:  APPLICATION SERVAL NUMBER PRUNCH CLAIMED TRUE SUBJECT TO THE SUBJECT TO THE ACT OF SECTION 112, I acknowledge the duty to disclose material to be completed by the Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the fifting date of the application and the national or PCT international filing date of this application:  APPLICATION SERVAL NUMBER PRUNCH STATUS (parametr) to prosecute this application and transact all business in the Parametr and Trademark Office connected therewith:  Customer Number 022979 Pand Panding  POWER OF ATTORNEY:  As a named inventor, I hareby appoint the following attorney(s) and/or agent(s) to prosecute this application and vanaset all business in the Parametra of Trademark Office connected therewith:								
NC) was filed on Sep 29, 1999 as US Application Serial No. or PCT International Application Number US99/23078 and was emended on [if applicable]. [if applicable].  It hereby state that I have reviewed and understood the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose all information which is material to patentability as defined in 37 CFR 1.56.  Foreign Applicational and/or Claim of Foreign Priority I hereby claim foreign priority banefits under Titls 35, United States Code Section 119 of any foreign application(s) for patent or inventorial certificate having a filing date before that of the application on which priority is claimed:  COUNTRY APPLICATION MANDERS DATE TABLE TRUE TRUE TABLE UNDER SUBJECT TO PCT/US99/23078 09/29/99 PTES X Not.  PCT PCT/US99/23078 09/29/99 PTES X Not.  PTOVISIONAL APPLICATION SERVAL NUMBER PRUNCH CLAIMED UNDER SUBJECT TO THE PCT/US99/23078 09/29/99 PTES X Not.  PROVISIONAL APPLICATION SERVAL NUMBER PRUNCH CLAIMED UNDER SUBJECT TO THE PCT/US99/23078 09/29/99 PTES X Not.  O, S. Priority Claim I hereby claim the benefit under Title 35, United States Code Section 119(a) of any United States provisional application(s) fisted below:  APPLICATION SERVAL NUMBER PRUNCH CLAIMED TRUE SUBJECT TO THE SUBJECT TO THE ACT OF SECTION 112, I acknowledge the duty to disclose material to be completed by the Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the fifting date of the application and the national or PCT international filing date of this application:  APPLICATION SERVAL NUMBER PRUNCH STATUS (parametr) to prosecute this application and transact all business in the Parametr and Trademark Office connected therewith:  Customer Number 022979 Pand Panding  POWER OF ATTORNEY:  As a named inventor, I hareby appoint the following attorney(s) and/or agent(s) to prosecute this application and vanaset all business in the Parametra of Trademark Office connected therewith:	the specification of wh	ich is a	ttached hereto u	nless	the following	box is ch	ecked:	
including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to discloses all information which is material to patentability as defined in 37 CPR 1.56.  Foreign Application(s) and/or Claim of Foreign Priority I hereby claim foreign priority benefits under Title 35. United States Code Section 119 of any foreign application(s) for patent or inventor(s) certificate listed below and have also identified below any foreign application for patent or inventor(s) certificate having a filing date before that of the application on which priority is claimed:  COUNTRY  APPLICATION APPLICATION APPLICATION ANNESS DATE PLED PROPERTY LAWED UNDER 35 U.S.C. 119  PTO Visional Application I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) fisted below:  APPLICATION SERAL NUMBER RUMA DATE  U. S. Priority Claim I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner proviced by the first paragraph of Title 35, United States Code Section 112, i acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.5(s) which occurred between the fifting date of the prior application and the hational or PCT International filling date of this application:  APPLICATION SERIAL NUMBER RUMA DATE STATUS (passed/pa/sindowed)  OS/162844 OS/29/1998 Pending  Power of ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and trensact all business in the Patent and Trademark Office connected therewith:  Customer Number Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these sta	(V) was filed on S	an 29.	1999 as U	S App	lication Seria	l No. or P	CT International	Application
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PCT PCT/USS9/23078 09/29/99	l hereby claim foreign priorit	y benefit	s under Title 35, Ui I have also identifie	d below	any foreign ap	ion 119 of a plication for	ny foreign applicati patent or inventor(s	on(s) for patent or certificate having
Provisional Application I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(s) fisted below:  APPLICATION SERIAL NUMBER FILMS DATE  APPLICATION SERIAL NUMBER FILMS DATE  OU. S. Priority Claim I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the information as defined in Title 37, Code of Federal Regulations, Section 1.55(a) which occurred between the filling date of the prior application and the national or PC International filling date of this application:  APPLICATION SERIAL NUMBER FILMS GATE  O9/162844 O9/29/1998 Pending  POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patonit and Trademark Office connected therewith:  Customer Number  Customer Number  O22879  Send Correspondence to:  HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, Colorade 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor: Steven W Trovinger  Residence:  1099 Parma Way Los Altos, CA 94204	COUNTRY		APPLICATION NUM	BEA	DATE	FILED	PRIORITY CLAIMED U	NDER 35 U.S.C. 119
Provisional Application  I hereby claim the benefit under Title 35, United States Code Section 119(e) of any United States provisional application(e) listed below:  APPLICATION SERIAL NUMBER  I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofer as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provised by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as distinct in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filling date of this application and the national or PCT international filling date of this application.  APPLICATION SERIAL NUMBER  APPLICATION SERIAL NUMBER  FILING DATE  APPLICATION SERIAL NUMBER  FILING DATE  STATUS (presental/panding/shindowed)  O9/162844  O9/29/1998  Peniding  Power of ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Parent and Trademark Office connected therewith:  Customer Number  O22879  Power of ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Parent and Trademark Office connected therewith:  Customer Number  O22879  Power of Customer Number  Direct Telephone Calls To:  HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 772400  Fort Collins, Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements made herein	PCT		PCT/US99/230	78	09/29/9	19 A	YES: X	NO:
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U. S. Priority Claim  I hereby claim the benefit under Tide 35, United States Code, Section 120 of any United States application (a) listed below and, insofar as the subject matter of each of the claims of this application in not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as disfined in Title 37, Code of Federal Regulations, Section 1.55(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:  APPLICATION SERIAL NUMBER  FILING DATE  STATUS (persuading/absindored)  O9/162844  O9/29/1998  Pending  Pending  Pending  Power OF ATTORNEY: As a named inventor, I hereby appoint the following atterney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:  Customer Number  Customer Number  Customer Number  O22879  Sand Cerrespondence to:  HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor:  Steven W Trovinger  Cittzenship: US  1501 Page Mill Road Palo Alto, CA 94304	I hereby claim the benefit us	nder Tide	35, United States	Code Si	action 119(a) o	f any United	States provisional a	application(a) listed
I hereby claim the benefit under Tide 35, United States Code, Section 120 of any United States application is insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.55(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:  APPLICATION SERIAL NUMBER  PUNCATION SERIAL NUMBER  FILING DATE  STATUS (privativid) pending/issindoned)  O9/162844  O9/29/1998  Pendling  POWER OF ATTORNEY:  As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:  Customer Number  Customer Number  O22879  Send Correspondence to:  HEWLETT-PACKARD COMPANY Intellectual Property Administration  P.O. Box 272400  Fort Colline, Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor:  Steven W Trovinger  Cittzenship: US  1099 Parma Way Los Altos, CA 94204  Post Office Address:  1501 Page Mill Road Palo Alto, CA 94304		AP	PLICATION SERIAL NUMB	ÉR	FILIN	G DATE	_	
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O9/162844  O9/29/1998  Pending  Power of Attorney:  As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademerk Office connected therewith:  Customer Number  O22879  Send Correspondence to:  HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins. Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor: Steven W Trovinger  Citizenship: US  Residence:  1099 Parma Way Los Altos, CA 94204  Post Office Address:  1501 Page Mill Road Palo Alto, CA 94304	I hereby claim the benefit un insofar as the subject matter manner provided by the first information as defined in Titl	r of each paragraph è 37. Com	of the claims of thi oh of Title 35, Unite de of Federal Regula	s applic d State itions, S	eation is not dis is Code Section Section 1.56(a)	cioseo in um 112. Lacko	owledge the duty t	o disclose material
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As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and business in the Patent and Trademark Office connected therewith:  Customer Number 022879  Send Correspondence to: HEWLETT-PACKARD COMPANY Intellectual Property Administration Fort Collins. Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor: Steven W Trovinger  Cittzenship: US  Residence:  1099 Parma Way Los Altos, CA 94204  Post Office Address:  1501 Page Mill Road Palo Alto, CA 94304	09/162844		09/29/1998		F	ending		
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Intellectual Property Administration P.O. Box 272400 Fort Collins. Colorado 80528-9599  I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor: Steven W Trovinger  Citizenship: US  1099 Parma Way Los Altos, CA 94204  Post Office Address:  1501 Page Mill Road Palo Alto, CA 94304					Dir	ect Telephon	e Calla To:	
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made on information and belief are believed to be true; and further that these statements with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.  Full Name of Inventor: Steven W Trovinger  Citizenship: US  Residence: 1099 Parma Way Los Altos, CA 94204  Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304	P.O. Box 272400				(650	857-5143		·
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Post Office Address: 1501 Page Mill Road Palo Alto, CA 94304	Full Name of Inventor: Ste	ven W	Trovinger		Clti	zenship: US		
7 /20	Residence: 10	99 Par	ma Way Los Alt	os, CA	94204			
7 /20	Post Office Address: 15	501 Pad	e Mill Road Palo	Alto,	CA 94304			
	In WYZ					11/23/9	9	

Date

# DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION (continued)

ATTORNEY DOCKET NO. 10991471-1

	Bass B Allen	Citizenship: US
Full Name of # 2 joint inventor:	408 Hainline Dr Belmont CA 94002	
Residence:	1501 Page Mill Road Palo Alto, CA 94	4304
Post Office Indress:	7501 Page Will Hoad Falo Alto, OA 54	
MARCE	Date	12/3/99
Inventor's Signature		
		Chizenship: US
Full Name of # 3 joint inventor	: Erik G Vaaler	
Residence:	707 Leahy Street # 216-B Redwood C	
Post Office Address:	1501 Page Mill Road Palo Alto, CA 9	
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Inventor a Signature	Date	•
	•	
Full Name of # 4 Joint Inventor	r:	Citizanship:
Residence:		
Post Office Address:		
Post Unice Address.		
Inventor's Signature	Date	te
Full Name of # 5 Joint invento	nr	Citizenship:
Residence:		
Post Office Address:		
Inventor s Signature	Dat	ite
		Citizenship:
Full Name of # 6 joint invent	or:	
Residence:		
Post Office Address:		
	Da	ate
Inventor's bignature		
		Citizenship:
Full Name of # 7 joint inven	tor:	
Residença:		
Post Office Address:		
		Date
inventor's Signature		·
		Citizenship:
Full Name of # 8 Joint Inver	ntor:	
Residence:		
Post Office Address:		
		Date
Inventor's Signature		<b></b>



#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):

Steven W. Trovinger

Group Art Unit: not available

Serial No.:

09/831,768

Examiner: not available

Filed: May 14, 2001

Title: Method and Apparatus for Making Booklets

Atty Docket: 10991471-9

#### PRELIMINARY AMENDMENT

Hon. Commissioner for Patents Washington, D.C. 20231

Sir:

Please consider the following preliminary amendment in connection with the divisional application of the above-noted application filed herewith.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 4 of this paper.

#### Amendments to the Specification

Page 1 of the application, after the Title please insert the following paragraph:

### CROSS-REFERENCES TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

#### Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the present application:

#### Listing of Claims:

Claims 1-39 (cancelled)

Claim 40 (currently amended) The method of claim 37 including the step of Method for stacking sheets of printing media, comprising the steps of:

a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein:

b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and punching a hole in the sheets, sheet-by-sheet:

c) unloading the stack of collected and registered sheets from the workpiece.

Claim 41 (currently amended) The method of claim 37 including the step of Method for stacking sheets of printing media, comprising the steps of:

a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;

b) registering the sheets on the workpiece. sheet-by-sheet, with the fold in each sheet and cutting out a notch in selected sheets, sheet-by-sheet:

c) unloading the stack of collected and registered sheets from the workpiece.

Claims 42-62 (cancelled)

#### REMARKS

Applicant respectfully requests consideration of the above preliminary amendment.

#### Amendments to the Specification

The present application is a divisional of an original parent application. A section entitled "CROSS-REFERENCES TO RELATED APPLICATIONS" has been added after the title indicating that the present application is a divisional of prior Application No. 09/831,768 filed May 14, 2001.

#### **Amendments**

Claims 1-39 and 42-62 are cancelled and Claims 40 and 41 are remaining.

Respectfully submitted,

Steven W. Trovinger

Susan E. Heminge

Reg. No. 36,449

October 27, 2003 Hewlett-Packard Company Legal Department IPA P.O. Box 272400 Fort Collins, CO 80527-2400

Confirmation No.: 9590

Group Art Unit: 3651

Patrick H. Mackey

HEWLETT-PACKARD COMPAN Intellectual Property Administration P. O. Box 272400 Fort Collins, Colorado 80527-2400

ATTORNEY DOCKET NO. \_\_ 10991471-13

Examiner:

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):

Steven W. TROVING

Application No.: 10/698,504

Filing Date:

Oct. 30, 2003

Title:

TRAUE MAN

METHOD AND APPARATUS FOR MAKING BOOKLETS

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

This Information Disclosure Statement is submitted:

( ) under 37 CFR 1.97(b), or (Within three months of filing national application; or date of entry of national application; or before mailing date of first office action on the merits; whichever occurs last)

(X) under 37 CFR 1.97(c) together with either a:

( ) Statement under 37 CFR 1.97(e), or

(X) a \$180.00 fee under 37 CFR 1.17(p), or

(After the CFR 1.97 (b) time period, but before final action or notice of allowance, whichever occurs first)

( ) under 37 CFR 1.97 (d) together with a:

( ) Statement under 37 CFR 1.97(e)(1) or (2), and

( ) a \$180.00 fee set forth in 37 CFR 1.17(p).

(Filed after final action, a notice of allowance, on or before payment of the issue fee)

Please charge to Deposit Account 08-2025 the sum of \$180.00 . At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25.

- (X) Applicant(s) submit herewith Form PTO 1449 Information Disclosure Statement together with any required copies of patents, publications or other information of which applicant(s) are aware, which applicant(s) believe(s) may be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR 1.56.
- ( ) A concise explanation of the relevance of foreign language patents, foreign language publications and other foreign language information listed on PTO Form 1449, as presently understood by the individuals(s) designated in 37 CFR 1.56 (c) most knowledgeable about the content is given on the attached sheet, or where a foreign language patent is cited in a search report or other action by a foreign patent office in a counterpart foreign application, an English language version of the search report or action which indicates the degree of relevance found by the foreign office is listed on form PTO 1449 and is enclosed herewith.

It is requested that the information disclosed herein be made of record in this application.

Date: 16 July 2004

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 1803 220 20<sup>th</sup> Street S, Arlington Virginia, 22202 of the United States Patent &

Trademark Office on the date indicated above.

(Attorney Signature and Reg. No.)

Rev 05/04 (105XML)

Respectfully submitted,

Steven W. TROVINGER

Steven W. Thovingen

Patrick C. Keane

Attorney/Agent for Applicant(s)

Reg. No. 32,858

Date: July 16, 2004

Telephone No.: (703) 836-6620

Oct. 30, 2003

#### PATENT APPLICATION

Sheet 1 of 3

FORM PTO-1449

LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

APPLICATION NO. CONFIRMATION NO. OCKET NO. 10/698,504 9590 10991471-13 APPLICANT Steven W. TROVINGER GROUP FILING DATE 3651

### REFERENCE DESIGNATION

#### U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appea
	1A	4,053,150	Oct. 11, 1977	LANE	
	1B	5,087,163	Feb. 11, 1992	ERDBORIES et al.	
	1C	5,346,350	Sep. 13, 1994	LUHMAN et al.	·
	<del> </del>	5,452,920	Sep. 26, 1995	PARKER	
	1E	5,465,213	Nov. 7, 1995	ROSS	
	1F	6,193,458 B1	Feb. 27, 2001	MARSH	
	1G	6,363,851 B1	Apr. 2, 2002	GERHARD et al.	
	1H	<del> </del>	Oct. 3, 2002	TROVINGER	
	11	2002/0146302	Oct. 10, 2002	TROVINGER	
	1J		Sep. 22, 1998	JORG	
		5,456,646	Oct. 10, 1995	CROWLEY	

### FOREIGN PATENT DOCUMENTS

				Check if
DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Translation attached
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	NUMBER	NUMBER DATE	NUMBER DATE OR APPLICANT	NUMBER DATE OR APPLICANT Relevant Passages/Figures Appear

## OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

10	U.S. Patent Application No. 10/084,460 filed February 28, 2002, entitled "Booklet Maker", Steve W. Trovinger.
1R	U.S. Patent Application No. 10/231,127 filed August 30, 2002, entitled "Booklet Maker and Method of Manufacturing A Booklet Maker", Steven W. Trovinger.
15	U.S. Patent Application No. 09/970,730 filed October 5, 2001, entitled "Sheet Foliding Apparatus", Steven W. Trovinger et al.
EXAMINER	DATE CONSIDERED

Rev 05/04 (PTO1449)

#### PATENT APPLICATION

9590

Sheet 2 of 3

**FORM PTO-1449** 

LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE **STATEMENT** 

(Use several sheets if necessary)

ATTY. DOCKET NO. 10991471-13

APPLICATION NO. CONFIRMATION NO.

10/698,504 APPLICANT

Steven W. TROVINGER

FILING DATE Oct. 30, 2003 **GROUP** 3651

#### REFERENCE DESIGNATION

#### **U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appear
	2A	5,632,587	May 27, 1997	COYETTE	
	2B	4,795,071	Jan. 3, 1989	JACOBS et al.	
	2C	4,575,296	Mar. 11, 1986	KOCKLER et al.	
	2D	4,484,501	Nov. 27, 1984	RAMCKE	
	2E	4,891,681	Jan. 2, 1990	FISKE et al.	
	2F	5,803,891	Sep. 8, 1998	HAAN et al.	
	2G	3,897,051	July 29, 1975	MULLER	
	2H	4,595,187	Jun. 17, 1986	BOBER	
	21	5,076,556	Dec. 31, 1991	MANDEL	
	2J	5,445,592	Aug. 29, 1995	RICHARDS	
	2K	4,640,611	Feb. 3,1987	OHDAKE et al.	

#### **FOREIGN PATENT DOCUMENTS**

	DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Check if Translation attached
2L					
2M					†
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2P					<del>                                     </del>

### OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

	20	P. Berger, "Investieren Mt Blick Auf Digitale Nischenprodukte" (in German), Vol. 34, No. 5, Sept. 17, 1998, page 45, Deutscher Drucker.
	2R	
	28	
EXAMINI		DATE CONSIDERED

### PATENT APPLICATION

Sheet 3 of 3

FORM PTO-1449

LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

ATTY. DOCKET NO.	APPLICATION NO.	CONFIRMATION	NO.
10991471-13	10/698,504	9590	
APPLICANT			
Steven W. TROVIN	GER		
FILING DATE	GROUP	<del>-</del>	
Oct. 30, 2003	3651		

#### REFERENCE DESIGNATION

#### **U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	PUBLICATION DATE	NAME	Pages, Columns, Lines Where Relevant Passages or Figures Appear
	ЗА	5,377,965	Jan. 3, 1995	MANDEL et al.	
	зв	5,241,474	Aug. 31,1993	MAROVAC	
	зс	5,108,082	Apr. 28, 1992	SHEA et al.	
	3D				
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	3F				
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	зк				

#### **FOREIGN PATENT DOCUMENTS**

	DOCUMENT NUMBER	PUBLICATION DATE	NAME OF PATENTEE OR APPLICANT	Pages/Columns/Lines Where Relevant Passages/Figures Appear	Check if Translation attached
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#### OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, etc.)

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EXAMINER		DATE CONSIDERED	

ATTORNEY DOCKET NO. 10991471-13

Confirmation No.: 9590

Group Art Unit:

Examiner: Patrick H. Mackey

3651

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):

Steven W. TROVING

Application No.: 10/698,504

Filing Date:

Oct. 30, 2003

Title:

METHOD AND APPA OR MAKING BOOKLETS

Mail Stop Amendment Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

#### TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

( )

Transmitted herewith is/are the following in the above-identified application:

Response/Amendment

Petition to extend time to respond ( ) Supplemental Declaration

New fee as calculated below ( )

No additional fee (X)

Other: Petition (X)

(fee \$

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(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	HIGHES"	(4) T NUMBER SLY PAID FOR	PRES EXT	ENT	F	(6) ATE	AD	(7) DITIONAI FEES
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1.330 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this document is being filed by personal delivery to the Customer Service Window, Crystal Plaza 2, 1B03 220 20th Street S, Arlington Virginia, 22202 of the United States Patent & Trademark Office on the date indicated above.

Attorney Signature and Reg. No.)

Respectfully submitted,

Patrick C. Keane

Attorney/Agent for Applicant(4): 1000 Reg. No. 32,852

Date: July 16, 2004

Rev 05/04 (TransAmd)

- Attach as First Page to Transmitted Papers -

Telephone No.: (703) 836-6620

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Attorney Signature and Reg No.)

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Attorney's Docket No. 10991471-13

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Steven W. TROVINGER

Application No.: 10/698,504

Filed: October 30, 2003

For: METHOD AND APPARATUS FOR MAKING BOOKLETS

Croup Art Unit: 3651

Examiner: Patrick H. Mackey

Confirmation No.: 9590

## AMENDMENT PURSUANT TO 37 C.F.R. §1.111

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

In response to the Official Action mailed April 16, 2004, please amend the above-identified patent application as follows:

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### **AMENDMENTS TO THE SPECIFICATION:**

Please replace the first paragraph after the title with the following paragraph:

## CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a divisional of prior Application No. 09/831,768 filed May 14, 2001, which is a § 371 National Stage Application of PCT International Application No. PCT/US99/23078 filed September 29, 1999, which International Application was published by the International Bureau in English on April 6, 2000, which is a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998, now abandoned.

#### AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions, and listings, of claims in the application:

#### **LISTING OF CLAIMS:**

Claims 1-39 (Canceled)

- 40. (Previously Presented) Method for stacking sheets of printing media, comprising the steps of:
- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and punching a hole in the sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.
- 41. (Previously Presented) Method for stacking sheets of printing media, comprising the steps of:
- a) collecting the sheets in a stack on a workpiece, sheet-by-sheet, said sheets each having a fold therein;
- b) registering the sheets on the workpiece, sheet-by-sheet, with the fold in each sheet and cutting out a notch in selected sheets, sheet-by-sheet;
- c) unloading the stack of collected and registered sheets from the workpiece.

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Claims 42-62 (Canceled)

#### **REMARKS**

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 40 and 41 were pending. By the present response, the specification has been amended. Thus, upon entry of the present response, claims 40-41 remain pending and await further consideration on the merits.

# CLAIM FOR BENEFIT OF EARLIER FILING DATE AND CROSS-REFERENCE TO RELATED APPLICATIONS

Enclosed herewith is a Petition Under 37 C.F.R. §1.78(a)(3) to Accept an Unintentionally Delayed Reference under 35 U.S.C. § 120 and/or § 365. The present amendment to the specification makes the cross-reference to related applications required under 37 C.F.R. §1.78. It is respectfully requested upon granting of the petition that this application be accorded the benefit of the earlier filing date, as provided under 35 U.S.C. §§ 363 and 365.

### CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 40 and 41 stand rejected under 35 U.S.C. §102(a) as being anticipated by WO 00/40425 to Scholta (hereafter "Scholta") on the grounds set forth in paragraph 3 of the Official Action. This rejection is respectfully traversed.

1. The date of invention of the present application based on a perfected priority date is prior to the date the Scholta PCT reference is available as prior art

The rejections are respectfully traversed because the *Scholta* reference is not prior art to the present application under the statutory standards set out in 35 U.S.C. § 102 and its use in a rejection of the present claims is improper.

The present application was filed under 35 U.S.C. §371 and, under 35 U.S.C. §363, has an effective filing date in the U.S. Patent and Trademark Office that is the same as the international filing date, e.g., September 29, 1999. Further, the international application is a Continuation-in-Part Application of U.S. Application No., 09/162,844, filed on September 29, 1998. The *Scholta* reference has an international application filing date of December 23, 1999 and was published in a non-English language on July 13, 2000. Thus, the present application was filed prior to the international filing date of the *Scholta* reference and prior to the publication of the *Scholta* reference.

Because the *Scholta* patent is not available as prior art against the application, Applicant respectfully requests the withdrawal of the rejections. Accordingly, all pending claims are considered allowable.

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#### CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 16, 2004

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